REMARKS

In the Office Action Summary it was indicated that claims 1-16 were pending in the application, claims 5-9 and 12-18 were withdrawn from consideration and claims 1-4, 10 and 11 were rejected, even though claim 17 had been canceled in the Amendment filed August 18, 2005. Claims 12-16 and 18 are canceled herein, leaving claims 1-11 pending. Since the withdrawn claims 5-9 all depend from claim 1, claim 1 is a generic claim and if it is allowed, claims 5-9 should be allowed also.

On pages 3-6 of the Office Action, claims 1-4, 10 and 11 were rejected under 35 USC § 103(a) as unpatentable over PCT Published Application WO 96/29578 (Reference N) in view of U.S. Patent 6,405,178 to Manchala et al. (Reference A). The rejections are traversed below.

Much of the wording of the rejection is unchanged from the April 18, 2005 Office Action. The new language appears on the last seven lines of page 3, the first three lines of page 4, the last paragraph on page 4, the first paragraph on page 5 and the "Remarks" at page 6, line 7 through page 7, line 5. Since the comments repeated from the April 18, 2005 Office Action were addressed in the August 18, 2005 Amendment, the following remarks primarily address the new comments in the November 4, 2005 Office Action.

The November 4, 2005 Office Action asserted that since the system taught by WO 96/29578 "compares projected to actual usage levels of product this difference must by definition include the variable of the time left because the formula for determining same is a function of time ... defined by gallons/day(actual)- gallons/day(theory)" (page 3, last 2 lines and page 4, first 2 lines).

It is submitted that there is no suggestion of "calculating a period left until a remainder quantity of the merchandise will be exhausted based on purchase history of a purchaser and the remainder quantity information" (claim 1, lines 4-6) in the way the "inventory management system 10 predicts storage tank product levels based on forecasted and actual usage rates" (WO 96/29578, page 17, lines 18-19) which is summarized in the formula on page 4, line 2 of the November 4, 2005 Office Action that is quoted above. As discussed in the Amendment filed August 18, 2005, using the predictions of storage tank product levels for actual and forecasted rates, "the inventory management system 10 determines whether a low product level will occur" (page 17, lines 29-30). This does not inherently determine "a period left until a remainder quantity of the merchandise will be exhausted" as recited in claim 1. Such a period could be calculated from the information available to the system taught by WO 96/29578, but there is no suggestion in WO 96/29578 that the period should be calculated and calculation of the period is

not necessary to determine "whether a low product level will occur" or to predict storage tank product levels. Rather, the information described in WO 96/29578 as being produced by the system can be used to calculate the period left, not the other way around, as apparently asserted in the November 4, 2005 Office Action.

Furthermore, as discussed in the August 18, 2005 Amendment, the inventory management system taught by WO 96/29578 does not take into account "purchase history of a purchaser" (claim 1, line 5), but only the date on which the next shipment is to be made to ensure that the chemical in the tank will not be depleted before the next shipment and there will be sufficient room in the tank to receive the full shipment. No response to this argument was found in the November 4, 2005 Office Action. Therefore, it is submitted that claim 1 further patentably distinguishes over the cited prior art for this additional reason.

In the November 4, 2005 Office Action, it was explained that "the calculated period" (presumably claim 1, line 12) was "read as the period in which the solicitation for quotes was made" (page 4, last 2 lines) in Manchala et al. However, Manchala et al. is not related to **calculating** any period for anything and, as noted above, WO 96/29578 does not teach or suggest calculating the "period left until a remainder quantity of the merchandise will be exhausted" (claim 1, lines 4-5). Therefore, it is submitted there is no basis in the prior art for considering "the period in which the solicitation for quotes was made" as a "calculated period." In reading this limitation of claim 1 on Manchala et al. in the manner described in the November 4, 2005 Office Action, claim 1 has been used improperly as a template in which the teachings of the cited references have been fit. A proper rejection under 35 U.S.C. § 103 requires that the prior art suggest the combination, not the claims (see, e.g., *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002) and the cases cited therein).

For the above reasons, it is submitted that claim 1 patentably distinguishes over WO 96/29578 in view of Manchala et al. Since claims 2-4, 10 and 11 depend from claim 1, it is submitted that claims 2-4, 10 and 11 similarly distinguish over the applied art for at least these reasons.

New Claims

Claims 19-24 have been added reciting limitations similar to those in claims 12-16 and 18 in the Amendment filed August 18, 2005. In the first paragraph on page 2 of the November 4, 2005 Office Action, it was asserted the election of claims 2-4 without traverse on January 13, 2005 prevents consideration of amended claims 12-16 and 18. However, the refusal to examine

amended claims 12-16 appears to have been based on the numbering of the claims, rather than the limitations recited therein.

The Restriction Requirement mailed December 14, 2004 stated that the reason the method recited in claim 12 was different from the apparatus recited in claim 1 was that "the method can be practiced by human intervention e.g., the step of calculating may be done by a human." Unlike original claim 12, claim 19 recites "automatically calculating " (claim 19, line 4), as well as "automatically selecting" (claim 19, line 10); "automatically preparing" (claim 19, line 13); and "automatically placing" (claim 19, line 14). Therefore the reason that original claim 12 was different from claim 1 does not apply to claim 19. In other words, claim 19-23 have not been "withdrawn by operation of law" as asserted in the November 4, 2005 Office Action, because there was no original claim with the limitations recited in claim 19 and the specific language on which the December 14, 2004 Restriction Requirement asserted the restriction of claim 12 was based is not present in claim 19.

In the second paragraph on page 2 of the November 4, 2005 Office Action, claim 18 was "withdrawn as drawn to ... another sub-combination relative to claim 1 in that there is no storage unit recited in the combination of claim 1. Claim 24 does not recite a storage; therefore, it is submitted that claim 24 is within the elected species and should be examined along with claims 1-4, 10, 11 and 19-23.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-16 and 19-24 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Request for Examiner Interview

It is respectfully requested that the Examiner contact the undersigned by telephone to arrange an Examiner Interview prior to issuing the first Office Action after consideration of this Amendment entered by the Request for Continued Examination submitted herewith. This will provide an opportunity to discuss how the prior art meets the limitations currently recited in the claims and what further amendments might clarify the distinctions of the invention over the prior art.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 5/3/06

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501